

### **REMARKS**

Applicant requests reconsideration and allowance in view of the following remarks. Claims 12-39 and 42-54 are pending in this application, with claims 12, 27, 42, and 49 being independent. Claims 42-54 have been added. No new matter has been introduced.

#### **§ 103 Rejections**

Independent claims 12 and 27, along with their dependent claims 15-18, 20, 21, 24-26, 29-32, 34, 35, 38, and 39, were rejected as being unpatentable over Bowen ("How to get the most out of COMPUSERVE, 4<sup>th</sup> edition, 1989"). Applicant respectfully requests reconsideration and withdrawal of these rejections because Bowen fails to describe or suggest all of the features of independent claims 12 and 27, as discussed more fully below.

For example, independent claim 12 recites enabling a first user to identify profile information with respect to a plurality of video games, the profile information including data that enables user determination of the skill of the first user for a first identified video game relative to a second identified video game. Bowen fails to describe or suggest at least these features.

Specifically, the Office Action acknowledges that "Bowen does not explicitly disclose that the interface enables user determination of the skill of a first user for a first identified video game relative to a second video game." Office Action of October 22, 2008 at pages 3-4. However, instead of turning to another reference for this feature or identifying independent claim 12 as being allowable, the Office Action indicates that this feature would be obvious to include in a system such as Bowen's. Applicant respectfully disagrees and submits that the proposed modification of the Bowen system to include an interface that enables user determination of the skill of a first user for a first identified video game relative to an identified second video game is based on impermissible hindsight gleaned from Applicant's specification, rather than an evaluation of Bowen's disclosure.

In *KSR Int'l v. Teleflex Inc.*, the Supreme Court warned that "a factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of argument reliant upon ex post reasoning." *KSR Int'l v. Teleflex Inc.*, 82 USPQ 2d 1385 at 1397 (2007). In addition, the M.P.E.P. acknowledges that the "tendency to resort to 'hindsight' based upon

applicant's disclosure is often difficult to avoid due to the very nature of the examination process," but instructs that "impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art." M.P.E.P. § 2142 (emphasis added). In the present instance, Applicant submits that the statements presented in the Office Action to support the proposed modification of the Bowen system are not based on facts gleaned from the prior art, but, instead, based on hindsight gleaned from applicant's disclosure.

In particular, the Office Action asserts that Bowen describes a system in which "users may enter any information they wish into their list of interests" and also "allows for multiplayer games with an active player base that engages in team and competitive play." Office Action of October 22, 2008 at page 3. From these two assertions, the Office Action concludes that, "in order to facilitate team creation and competitive play," it would have been obvious that a user could have "provided an indication of player skill in [video games] so that other users may find players of the skill level desired to play against." Id.

However, although Bowen describes multiplayer games, Bowen is devoid of any mention of providing an indication related to player skill level in the multiplayer games. Bowen merely describes providing a profile with a general list of interests (e.g., "Flying, fishing, jazz, painting") as "a way to find out a little something about those who are using [the Bowen system]." Bowen at pages 94-95. As such, the profile described by Bowen includes personal interests, not skill levels in games. Therefore, providing an indication of player skill level is not a fact gleaned from the prior art, but rather is a "fact" constructed by the Office Action based entirely on impermissible hindsight gleaned from applicant's own disclosure.

Accordingly, applicant submits that Bowen fails to describe or suggest enabling a first user to identify profile information with respect to a plurality of video games, the profile information including data that enables user determination of the skill of the first user for a first identified video game relative to a second identified video game, as recited in independent claim 12. For at least these reasons, Applicant respectfully requests reconsideration and withdrawal of the rejection of independent claim 12 and its dependent claims.

Independent claim 27 recites enabling a first user to access an interface that includes profile information of a second user with respect to a plurality of video games, the profile information included in the interface enabling user determination of a skill level of the second

user for a first identified video game relative to a second identified video game. Accordingly, for reasons similar to those described above with respect to independent claim 12, Applicant respectfully requests reconsideration and withdrawal of the rejection of independent claim 27 and its dependent claims.

### **New Claims**

New independent claim 42 recites, among other things, enabling a first user to identify first profile information with respect to each of one or more video games, the first profile information including, for each of the one or more video games, a level of interest that is selected from among the several displayed gradations of interest, enabling the first user to identify second profile information with respect to personal characteristics of the first user, the second profile information including one or more personal interests of the first user, the one or more personal interests indicating whether or not the first user has the corresponding personal interest without specifying a level of interest in the corresponding personal interest, and saving, in electronic storage, the first profile information and the second profile information as a user profile for the first user. Applicant submits that none of the cited references describe or suggest at least these features. Accordingly, Applicant submits that new independent claim 42 and its dependent claims are allowable.

New independent claim 49 recites features similar to those discussed above with respect to claim 42, but does so in the context of a system. Accordingly, Applicant submits that new independent claim 49 and its dependent claims are allowable.

### **Conclusion**

It is believed that all of the pending issues have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this reply should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this reply.

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Page : 15 of 15

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Applicant submits that all claims are in condition for allowance. Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

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